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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/521,158	01/13/2005	Ryo Minamida	2185-0743PUS1	8741
2292 7590 01/11/2007 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			EXAMINER OH, TAYLOR V	
			ART UNIT	PAPER NUMBER
			1625	

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
3 MONTHS	01/11/2007	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 01/11/2007.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/521,158	MINAMIDA ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Taylor Victor Oh	1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 October 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **Final Rejection**

### **The Status of Claims**

Claims 1-8 are pending.

Claims 1-8 are rejected.

### **Claim Objections**

The Objection of Claim 2 is objected due to the modification of the claims in the amendment.

### **Claim Rejections - 35 USC § 112**

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The rejection of Claims 1-8 under 35 U.S.C. 112, second paragraph, has been withdrawn due to the modification of the claims in the amendment.

### **Claim Rejections - 35 USC § 103**

1. Applicants' argument filed 10/26/06 have been fully considered but they are not persuasive.

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**The rejection of Claims 1-8 under 35 U.S.C. 103(a) as being unpatentable over Krief (US 4,408,066) in view of Anelli et al (J. Org. Chem. 1987, 52, p. 2559-2562)**

The rejection of Claims 1-8 under 35 U.S.C. 103(a) as being unpatentable over Krief (US 4,408,066) in view of Anelli et al (J. Org. Chem. 1987, 52, p. 2559-2562) has been maintained with reasons of record filed on 7/26/06.

### **Applicants' Argument**

a. The Krief does not disclose the oxidizers, such as hypochlorite and nitroxy compound, whereas Anelli et al does not teach a cyclopropane ring, particularly, the formylcyclopropanecarboxylate compound of the claimed invention;

b. The oxidizing agents disclosed by the Krief are not radical compounds, but they are the heavy metals; also, Anelli et al does not teach a hypochlorite, which is not one of the heavy metals, therefore, they are not obviously motivated to combine the prior art.

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Applicants' arguments have been noted, but the arguments are not persuasive.

First, regarding the first and second arguments, the Examiner has noted applicants' arguments. However, Krief expressly teaches a method for converting from 2,2-methyl-3-hydroxymethyl-cyclopropane-1-carboxylate to 2,2-methyl-3-formyl-cyclopropane-1-carboxylate in the presence of an oxidizing agent, such as chromic anhydride and pyridine hydrochloride in methylene chloride (see col. 6, lines 60-66).

However, the instant invention differs from the prior art in that the use of claimed oxidizer hypochlorite and nitroxy compound, hydrogen carbonate are unspecified.

Anelli et al does teach a generic process for oxidizing any primary alcohols, which may include a cyclopropane ring with an alcohol substituent, to the corresponding aldehyde in the presence of hypochlorite and nitroxy compound. Both prior art have shared a common oxidation process for producing the aldehyde product from the alcohol by using an oxidizing agent. There is no difference with respect to their functionality as the oxidizer among hypochlorite and nitroxy compound and chromic anhydride and pyridine hydrochloride in the absence of an unexpected result. Therefore, it would have been obvious to the skilled artisan in the art to be motivated to employ Anelli's et al hypochlorite and nitroxy compound as an alternative to chromic anhydride and pyridine hydrochloride oxidizer in order to enhance the selective oxidation of the primary alcohol to the corresponding desired aldehyde product. This is because the skilled artisan in the art would expect such a modification to be successful and efficient as shown in the prior art. Therefore, the prior art are still relevant to the claimed invention.

### Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taylor Victor Oh whose telephone number is 571-272-0689. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas McKenzie can be reached on 571-272-0670. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Taylor Victor Oh, MSD,LAC  
Primary Examiner  
Art unit : 1625

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